"Touch The Future" publication; and rejected claims 34-38 and 53 under the judicially created Doctrine of Obviousness-type Double Patenting as being unpatentable over claims 1-20 of U.S. Patent No. 5,751,221 in view of Smith et al., Kott, Wakura, and Kubota. Each of the above rejections is respectfully traversed for the reasons stated below under headings delineating the various rejections.

In reviewing the Office Action, Applicants note that the Examiner did not present any rejections to claims 59-63. In the absence of a rejection, Applicants assume that claims 59-63 recite allowable subject matter. Notification to this effect is respectfully requested.

CLAIMS 34-38 AND 53 ARE REJECTED UNDER THE JUDICIALLY CREATED DOCTRINE OF OBVIOUSNESS-TYPE DOUBLE PATENTING AS BEING UNPATENTABLE OVER CLAIMS 1-20 OF U.S. PATENT NO. 5,751,221 IN VIEW OF SMITH ET AL., KOTT, WAKURA, AND KUBOTA

Applicants respectfully traverse this rejection on the basis that a Terminal Disclaimer relative to U.S. Patent No. 5,751,221 has already been filed in this application. The Terminal Disclaimer was filed on February 1, 1999. Therefore, this rejection is improper and must be withdrawn.

CLAIMS 1-6, 11-14, 16, 18, AND 38-41 ARE REJECTED UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER SMITH ET AL. AND EITHER GILLOTTE OR KOTT

Applicants first wish to point out claims 1, 11-13, and 38-41 were previously rejected over Smith et al., Gillotte or Kott and Applicant's had responded to that rejection by filing an Appeal Brief on November 20, 2000. In the Office Action, however, the Examiner did not address any of the arguments presented in the Appeal Brief. It should be noted that although the arguments in the Appeal Brief did not address claims 2-6, 14, 16, and 18, those claims are all dependent from independent claim 1 and thus the same arguments apply with respect to these dependent claims.

Applicants respectfully request the Examiner to address the arguments presented in the Appeal Brief with respect to the above claims. Applicants have therefore reproduced portions of the arguments in the Appeal Brief below for the Examiner's consideration.

Smith et al. discloses an apparatus and method for monitoring the location of a plurality of computer tapes and for identifying the current location of a selected tape. More particularly, the apparatus includes at least one tape carrier (12a-12o, Fig. 6) each having a plurality of slots (30, Fig. 2) for receiving a tape cartridge (10, Fig. 1). Each slot includes a contact pad 38 (Fig. 3A) including a plurality of electrical contacts for contacting corresponding contacts 22 (Figs. 1 and 3B) provided on the tape cartridge 10. Each tape cartridge includes a memory device for storing a unique volume/serial number identifying that tape cartridge. As shown in Fig. 13, the contact pad (38a-38c)associated with each slot includes four contact terminals (40a-40d) - two for receiving power, one for providing an enable signal to the memory device on the tape cartridge positioned within the slot, and one for receiving the unique volume/serial number from the memory device on the tape cartridge provided therefrom when an enable signal is sent to the contact pad associated with the slot in which the tape cartridge is located.

Referring to Fig. 6 of Smith et al., each of the tape carriers 12 includes a control circuit 42 having a microcontroller 300 (Fig. 13) that is coupled to a host computer 52. When a particular tape cartridge is to be located using this apparatus, the volume/serial number of the tape is input into host computer 52 and subsequently transmitted from the host computer to each of the control circuits 42 associated with the tape carriers 12. The microcontrollers 300 within the control circuits 42 respond to the tape request signal including the volume/serial number by polling the memories of each tape cartridge stored in one of its slots to determine whether a tape having the requested volume/serial number is present in the associated tape carrier 12.

To poll each of the tape cartridges, microcontroller 300 transmits an enable signal over a dedicated line 45b, 332, or 334 (Fig. 13) associated with a particular slot of the tape carrier. If there is a tape cartridge in that slot, the memory device of the tape cartridge responds to the enable signal by allowing its volume/serial number to be read by microcontroller 300 over line 45a, which is commonly connected to all of the slot contact pads. By knowing to which slot it last sent an enable signal, microcontroller 300 knows to which slot a received volume/serial number corresponds. Microcontroller 300 thereby stores the received volume/serial number in

its memory at an address location dedicated to the particular slot from which the volume/serial number was received. Microcontroller 300 then sequentially and separately enables the memory devices of each tape cartridge stored in one of its slots and stores the volume/serial number sent by those tape cartridges in memory address locations associated with each respective slot.

Once polling is completed, microcontroller 300 compares the requested volume/serial number received from host computer 52 to the volume/serial numbers stored in its memory. If the requested volume/serial number is not found in its memory, microcontroller 300 does not respond to host computer 52. If microcontroller 300 determines that the requested volume/serial number corresponds to a volume/serial number stored in its memory, microcontroller 300 signals host computer 52 by identifying itself to host computer 52 and then illuminates a lamp positioned on the front of the tape carrier that is associated with the slot in which the requested tape is located. Meanwhile, host computer 52 displays the identification of the tape carrier whose microcontroller responded to the tape request.

The Kott patent discloses a docket card-locating device whereby each docket card folder includes a memory having a unique code stored therein, and an indicator light that is illuminated when a control signal is sent over a conductive rail upon which the docket card folders are hung that includes the code stored in the memory for that docket card folder. The Kott device, however, does not disclose that the devices on each docket card folder can, in any way, send reply signals back to the control circuit. Further, the Kott device does not maintain any form of database including the identification codes of the docket cards contained within the docket card box.

The Gillotte patent discloses a system for locating file folders. It discloses a shelving unit having a pair of electrical conductors for providing power to the signal means 22 on each folder. The signal means 22 receives and transmits data to a remote computer via wireless signaling. The electrical conductors 24 and 26 are only provided for the supply of power to the signal means 22. No data is transmitted on these conductors. Additionally, the electrical conductors 24 and 26 are not coupled to a processor.

Applicants respectfully submit that a *prima facie* case of obviousness has not been established. The requirements for making a *prima facie* case of obviousness are described in MPEP §2143 as follows:

> To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.
>
> The teaching or suggestion to make the claimed combination and the reasonable expectation of success ***must*** both ***be found in the prior art***, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). [Emphasis added]

Applicants submit that one of ordinary skill in the art would not have considered modifying the Smith et al. system to incorporate the features of Kott or Gillotte. Further, even assuming that one skilled in the art would have been motivated to make such a combination, the combined teachings of Smith et al., Kott, and Gillotte fail to teach or suggest each and every element recited in each of the claims.

MPEP §2143.01 provides further guidance as to what is necessary in showing that there was motivation known in the prior art to modify a reference teaching. Specifically, MPEP §2143.01 states:

> The mere fact that references <u>can</u> be combined or modified does not render the resultant combination obvious ***unless the prior art*** also ***suggests the desirability of the combination***. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). [Emphasis added]

For the reasons stated below, Applicants submit that the requisite motivation for combining the teachings of the Smith et al., Kott, and Gillotte patents has not been established, and therefore, *prima facie* obviousness has not been established. More specifically, Applicants submit that neither Smith et al., Kott, nor Gillotte suggest the ***desirability*** of the modification that would be necessary to provide a system that even remotely resembles the claimed invention.

Independent claim 1 defines a file tracking system comprising a combination of elements including at least "a plurality of file folders, each file folder including an addressable device adapted to be electrically connected to said bus when the file folder is placed in said folder retainer, *each addressable device being responsive to a control signal* ***including the unique address*** *associated with the addressable device* to transmit a signal back to said processor so that said processor may maintain the file location of each file in said database."

As generally discussed above, this aspect of the present invention contributes to the system's ability to track the location of files particularly when a hierarchy of addressable switches is employed for each folder retainer and bus segment. Specifically, the processor may locate a requested file by activating the bus segments between the processor and the last known location of the requested file (including the segment of the bus in a particular folder retainer), transmitting a control signal including the unique identification code of the file on the activated segments of the bus, and awaiting receipt of a return signal from the requested file folder that indicates that the requested file folder is located in the folder retainer having its connecting bus segment activated at that time. If no return signal is received, the processor sequentially activates each segment of the system bus until a return signal is received, at which point the processor can identify the location of the file folder.

The Smith et al. system is designed to track tape cartridges or other articles when placed in separate slots. The system is constructed for use in computer tape cartridge libraries where robotic arms remove and place the tape cartridges in their respective slots. To track file folders, the system would require that a separate slot be provided for each file folder. Such an arrangement is clearly impractical in an office environment where file folders may be stacked on top of one another on a desk, hanging in a vertical file cabinet, or placed on the shelf of a book cabinet. Despite the fact that the background portion of the Smith et al. patent refers to the organization and management of "articles such as books, tapes, cassettes, and the like," one skilled in the art who was seeking to construct a practical system for tracking file folders in an office environment clearly would not have considered a system such as that disclosed in Smith et al.

As discussed above, Smith et al. system has dedicated lines run to each slot in a tape carrier such that a memory enable signal may be specifically directed to the contact pad in a slot where a tape cartridge may be positioned. The Smith et al. patent does not disclose or suggest the need to transmit a unique address of a particular tape cartridge to the tape itself over the dedicated line. Because the memory enable signal that is sent by the processor in Smith et al. to each tape cartridge is sent over a separate isolated dedicated line, there is absolutely no need to transmit the unique address (*i.e.*, volume/serial number) of the tape cartridge over that line to cause it to respond by transmitting its volume/serial number back to the processor. Further, because the processor does not access a database prior to sending a polling signal, it would not know which volume/serial numbers to transmit over each dedicated line, nor would it know how to obtain a response from a tape cartridge that was newly added into a tape carrier slot since it would not know its volume/serial number to begin with. Thus, Smith et al. does not teach or suggest that each addressable device on the tape cartridges be responsive to a control signal that includes the unique volume/serial number associated with that tape cartridge to transmit a signal back to the processor, as required by independent claim 1.

In the remarks portion of the Office Action mailed June 22, 2000, the Examiner characterized Applicants' prior arguments as follows:

> a. The applicant argues that the references do not show an addressable file folder responsive to a control signal including a unique address to transmit a signal back to the processor so that the processor may maintain the file location in a database.

With respect to the above paragraph, the Examiner quotes the Abstract of Smith and contends:

> It is clear from this section of Smith shows [sic] an addressable file folder responsive to a control signal including a unique address to transmit a signal back to the processor (footnote 2 above) so that the processor may maintain the file location in a database (footnote 1 above).

Applicants submit that the Abstract of Smith et al. does not support the above-quoted conclusions. Nowhere does the Abstract of Smith et al. state that the control signal to which

the addressable file folders would be responsive would include a unique address of the file folder. While the Abstract of Smith et al. does disclose that the system polls and searches the system to identify the carrier in which a requested article is stored, the manner by which the Smith et al. system polls and searches the system to identify the location of such a cartridge is much different than that utilized in the claimed invention. Specifically, the Smith et al. system merely transmits a memory read enable signal separately to each of the tape cartridges over a dedicated line coupled to an associated slot such that the tape cartridge in the slot will respond by transmitting its unique volume/serial number back to the polling controller. Thus, the control signal clearly does not include a unique address corresponding to the tape carrier nor would there be any reason to modify the Smith et al. system such that a unique address is transmitted to each tape cartridge.

As discussed further below, neither Gillotte nor Kott teaches or suggests an addressable file folder responsive to a control signal including a unique address, to transmit a signal back to the processor. Thus, neither Gillotte nor Kott teaches or suggests the deficiency noted above with respect to Smith et al. Further, because Smith et al. utilizes a dedicated line connected between the processor and each separate tape cartridge slot, there would be absolutely no reason why the processor would need to transmit a control signal that included a unique address for a tape cartridge. While the host processor of Smith et al. may transmit the volume/serial number of a requested tape cartridge, the volume/serial number transmitted from the host processor is never received by the tape cartridge itself. Thus, one skilled in the art would not have found it to be desirable to modify the Smith et al. system based on the teachings of Kott or Gillotte.

As noted above, Kott discloses a device for locating docket cards in a box whereby a controller transmits a signal including a unique ID code of a selected docket card simultaneously to all the docket cards in the box. An indicator on the docket card having the unique ID code then illuminates. The indicator devices in the Kott device do not transmit any signals back to the controller.

Although it is not very clear how exactly the Examiner believes that one of ordinary skill in the art would have constructed a system based upon the combined teachings of Smith et

al. and Kott, it is apparent that there are certain features of Kott that one of ordinary skill in the art would not have considered implementing in the Smith et al. system since it would destroy some important functions that are performed by the Smith et al. system. For example, because the Smith et al. system utilizes a dedicated and separate line for each tape slot and indicator light, the Smith et al. system does not transmit the identification code of the tape to the tape itself or to the indicator light at any time. Although the Kott patent does require that the code for the file be transmitted to the indicator device mounted on the docket card folder, the fact that the Kott docket card box does not allow for the docket card folders to transmit their identification codes back to a processing circuit would destroy the ability of the Smith et al. system to determine the location of a particular item in a plurality of such retainers if the particular implementation in Kott were somehow used in the Smith et al. system.

It is not at all clear how or why one skilled in the art would modify the Smith et al. system based on the teachings of Gillotte. As noted above, Gillotte discloses the wireless transmittal of locating signals between the controller and a file case. If Smith et al. were modified based on the teachings of Gillotte, it would not recite all the features recited in the pending claims. Specifically, the processor would no longer be coupled to the folder retainer by a bus, as recited in claim 1.

As stated above, there would have been no reason why one skilled in the art would have considered modifying the Smith et al. system based on either Kott or Gillotte, and even if such motivation existed, the resultant system would not include all the features of claim 1. Thus, claims 1 and 11-13 are allowable over Smith, Kott, and Gillotte whether considered separately or in combination.

Independent claim 38 is directed to an electric file tracking system that includes the features presented in original independent claim 1 except for a bus and a database, and further recites that each file folder includes a conductor located on the file folder and is configured so as to electrically couple the addressable device on each file folder to the electrical contacts of the folder retainer when the folder retainer is positioned in any one of several different positions, wherein the conductor (which couples the addressable device to the processor) is configured to electrically couple the addressable device to the electrical contacts of the folder

retainer *at a plurality of locations on the file folder*. None of the cited references teaches or suggests this feature. Specifically, in Smith et al., the tape cartridges do not include conductors that are configured to couple the memory device to the contacts in the tape carrier when the tape cartridge is positioned in one of several different positions. Clearly, the slots and tape cartridges are dimensioned such that the tape cartridges may not be positioned in the tape carrier in more than one position such that electrical contact could still be made. Further, the contacts of the tape cartridge are not located at a plurality of locations on the tape cartridge.

The Kott reference does not disclose that the electrical contacts on the docket card folders would continue to make contact if the position of the docket card folder were in any different position than that disclosed in the patent, nor that the electrical contacts are positioned a plurality of locations on the docket card. The Gillotte patent does not disclose that such electrical conductors electrically couple the addressable device to the electrical contacts of the folder retainer, which, in turn, are coupled to the processor, nor does Gillotte disclose providing contacts on a plurality of locations on a file folder.

In the remarks portion of the Office Action mailed June 22, 2000, the Examiner characterized Applicants' prior arguments as follows:

> b. The applicant argues that the references do not showa [sic] retainer contacting the bus when the retainer is in any one of several different positions.

Regarding the above paragraph, the Examiner explains:

> Regarding claim 38, the claims previously required coupling when the retainer is positioned in one of several different positions. As it has been previously discussed, the references to Kott and Gillotte both show this since the retainers of the references at least are coupled in one position.
>
> In the claims however, in order to overcome the above interpretation, the applicant has amended to require coupling when the retainer is positioned [sic] any one of several positions. First it is believed that this language does not overcome the above interpretation, in that the references each show coupling in one orientation. Secondly, the references read on the claim language since there is coupling whether the retainer is the first retainer in the cabinet and also if the retainer is positioned in the back of the row. Therefore, there is coupling in any one of several positions.

Applicants submit that the Examiner has apparently misunderstood Applicants' prior arguments as well as the claims. Specifically, claim 38 recites "for at least one file folder, said conductor is configured to electrically couple said addressable device to the electrical contacts of said folder retainer at a plurality of locations *on said file folder*." Regardless of whether a file folder in Kott is placed at the front or back of the file cabinet, the conductor on the file folder is not configured to electrically couple the addressable device carried on the file folder to the electrical contacts of the folder retainer "at a plurality of locations on said file folder," as recited in claim 38. Instead, the conductors on the Kott file folder contact the electrical contacts of the retainer at only one location *on the file folder* despite the fact that the folder contacts the retainer contacts at several locations *along the container contacts*. Neither Smith nor Gillotte teaches or suggests this deficiency with respect to the teachings of Kott. Accordingly, none of the references, whether considered separately or in combination, teaches or suggests the features recited in independent claim 38. Thus, independent claim 38 as well as claims 39-41, which depend therefrom, are allowable over the teachings of Smith and either Kott or Gillotte.

As stated above, there would have been no reason why one skilled in the art would have considered modifying the Smith et al. system based on either Kott or Gillotte, and even if such motivation existed, the resultant system would not include all the features of claim 1. Thus, claims 38-41 are allowable over Smith, Kott, and Gillotte whether considered separately or in combination.

With respect to claims 2-6, 14, 16, and 18, which were not specifically addressed in the Appeal Brief, Applicants note that each of these claims depends from independent claim 1 and submits that these claims are allowable for at least those reasons stated above with respect to independent claim 1. With respect to dependent claim 3, Applicants also note that none of the cited references whether considered separately or in combination teaches or suggests a file tracking system wherein, when an operator inputs a command to search for a specific file, a processor accesses a unique address and file location stored in a database as corresponding to input the file information identifying a specific file to be searched for, and that the processor then displays the file location, and transmits a control signal including the unique address to

the addressable switch of the file folder containing the specific file causing the addressable switch to activate the indicator.

CLAIMS 7 AND 8 ARE REJECTED UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER SMITH ET AL., GILLOTTE, KOTT, AND FOSTER

Claims 7 and 8 depend from claim 1 and are therefore believed to be allowable for at least those reasons stated above with respect to claim 1. Applicants note that Foster does not teach or suggest the deficiencies of the combination of Smith et al., Gillotte, and Kott as applied to claim 1 and therefore, claims 7 and 8 are allowable for at least that reason.

In the Office Action, the Examiner states that Foster shows a file locating system which includes a PC to record and display the location of files thereby providing assistance to the user and determining the location of a desired file. The Examiner concludes that it would have been obvious to one skilled in the art to have used a PC for storing and displaying the location of a desired file since such would assist the user in determining the location of a desired file. However, it is noted that the Examiner did not specifically address the features recited in claim 7. Claim 7 states that the processor includes "polling means" for periodically polling said file folders to determine the presence and location of each file folder and means for updating said database when said polling means determines that a file location is different from the location previously stored or that a file that said database previously indicated as present is no longer present." Applicants submit that neither Smith et al., Gillotte, Kott, nor Foster teaches or suggests such a feature whether the references are considered separately or in combination.

CLAIMS 9 AND 10 ARE REJECTED UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER SMITH ET AL., GILLOTTE, KOTT, FOSTER, AND DOYLE

Claims 9 and 10 depend from independent claim 1 and therefore include all the features of claim 1. Neither Doyle nor Foster teaches or suggests the deficiencies noted above with respect to Smith et al., Gillotte, and Kott as applied to independent claim 1. Accordingly, Applicants submit that claims 9 and 10 are allowable over these references for at least the reasons stated above.

CLAIM 15 IS REJECTED UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER SMITH ET AL., GILLOTTE, KOTT, AND "TOUCH THE FUTURE"

Claim 15 depends indirectly on independent claim 1. Applicants submit that the "Touch The Future" publication fails to teach or suggest the deficiencies noted above with respect to Smith et al., Gillotte, and Kott as applied to claim 1. Accordingly, claim 15 is allowable for at least the reasons stated above.

In the Office Action, the Examiner states that the "Touch The Future" publication shows the use of trays for holding objects that are to located. Despite such teaching, however, the tray disclosed in the "Touch The Future" publication fails to include first and second conductors positioned in the tray for making contact with a file folder placed within the tray. Accordingly, Applicants submit that claim 15 is allowable for this additional reason.

CLAIM 17 IS REJECTED UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER SMITH ET AL., GILLOTTE, KOTT, AND LEIGHTON

Claim 17 depends indirectly upon independent claim 1 and therefore includes all the features recited in independent claim 1. Applicants submit that Leighton fails to teach or suggest the deficiencies in the combined teachings of Smith et al., Gillotte, and Kott with respect to independent claim 1. Accordingly, claim 17 is allowable for at least those reasons stated above with respect to claim 1.

Applicants additionally note that claim 17 recites that the first and second conductive rails are positioned along a bottom of the file drawer. To the extent that one skilled in the art would have considered placing the conductive rails on the bottom of the file drawer, Applicants submit that this would defeat the functionality of the file folders disclosed in Kott, upon which the Examiner relies in making the rejection to claim 1. Specifically, if the conductive rails were provided on the bottom of the file drawer rather than on the rails upon which the folders are hung, the indicator devices on the Kott folders would be unable to make electric conduct with the conductors.

CLAIMS 19-45 AND 47-58 ARE REJECTED UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER SMITH ET AL., KOTT, AND EITHER WAKURA OR KUBOTA

Due to the number of independent claims falling within this rejection, separate subheadings are provided for each set of claims.

CLAIM 19

Independent claim 19 defines a file tracking system in which, not only do the file folders include an addressable switch and indicator that is activated when a control signal is received including a unique address corresponding to the file folder, but also where the folder retainers are additionally connected to the bus via an addressable switch having its own unique address. Further, claim 19 recites that the processor identifies a first unique address and file location stored in the database as corresponding to input file identification information identifying the file to be searched for while also identifying a second unique address in the database for the addressable switch of the folder retainer in which the searched for file is located. The processor then transmits a control signal that energizes a segment of the bus within the folder retainer corresponding to the searched for file and transmits a control signal including the second unique address to the addressable switch of the folder retainer causing an indicator on the folder retainer to activate, and then transmits a control signal including the first unique address to the addressable switch of the file folder containing the specific file causing the addressable switch to activate the indicator located on the file folder. None of the references whether considered separately or in combination teaches a system whereby two unique addresses are transmitted in a single file request.

In the Office Action, the Examiner merely points that Wakura and Kubota disclose a file locating system that sends requests to locate files to cabinets that each file cabinet is in communication with the files it is currently storing and that the computer has a display to assist the user in finding the located file. Such a system, however, would not result in the specific structure that is presently claimed in independent claim 19. Moreover, it is not at all clear why one skilled in the art would have considered modifying the Smith et al. system to include such a feature since the feature is designed for use with a robotic arm that is moved to

the identified location of the tape. The robotic arm would not require any use of the identification of a particular cabinet in which the tape is stored since each location is otherwise unique and identifiable by the robotic arm.

Accordingly, Applicants submit that Smith et al., Gillotte, Kott, Wakura, and Kubota, whether considered separately or in combination, fail to teach or suggest each and every feature recited in independent claim 19.

CLAIMS 20-22

Independent claim 20 recites that the file tracking system includes a database for maintaining the file location and unique file folder address for a plurality of files, as well as a unique drawer addressed for each file drawer in which the files are located. The system further includes a plurality of file cabinets each including a plurality of file drawers having an addressable drawer indicator switch that illuminates a drawer indicator light when the addressable indicator switch receives a control signal from the processor including the unique drawer address corresponding to the file drawer. Neither Smith et al., Kott, Wakura, nor Kubota together or separately teaches or suggests any similar structure. Applicants therefore submit that independent claim 20, as well as claims 21 and 22 which depend therefrom are allowable over the teachings of these references. As stated above with respect to independent claim 19, there does not appear to be any motivation present in the prior art as to why one skilled in the art would have realistically considered modifying the Smith et al. system to include unique addresses for a folder retainer such as a file cabinet. The Examiner's conclusions to the contrary in the absence of such evidence clearly suggests that the Examiner has utilized impermissible hindsight to reconstruct the claimed invention.

CLAIMS 23-27

Independent claim 23 defines a method of locating a file including at least the step of transmitting a first control signal to the receiver at the present location of the file, where the first control signal includes the unique identification code of the receiver, and transmitting a second control signal to the file that includes the unique identification code of the file. These

steps relate to the hierarchy employed by the present invention that maintains not only a unique identification code for each file, but also a unique identification code associated with a receiver at the present location of the file. It is through the use of this hierarchy that this present invention may determine and track the location of files within the system. With respect to independent claim 23, Smith et al. does not disclose a method of locating a file including the step of transmitting a first control signal to a receiver at the present location of the file to be located, where the first control signal includes the unique identification code of the receiver, and the step of transmitting a second control signal to the file that includes the unique identification code of the file. As pointed out above, the Smith et al. computer only provides the volume/serial number of the requested tape and does not transmit an identification code of any form to a separate receiver located at the location of the file as determined by accessing a database. Neither Kott, Wakura, nor Kubota teaches or suggests this feature. Again, there does not appear to be any motivation why one skilled in the art would have considered modifying the Smith et al. system to include the transmittal of two separate identification codes for a single file request.

For these reasons, Applicants submit that independent claim 23, as well as claims 24-27, which depend therefrom are allowable over the teachings of Smith et al., Kott, Wakura, and Kubota whether considered separately or in combination.

CLAIMS 28 AND 29

Independent claim 28 is directed to a method of locating a file including at least the steps of accessing the database to determine a present location of the file, a unique identification code associated with a folder retainer in which the file is located, and a unique identification code associated with the file; and transmitting a control signal to the file, the control signal including a unique identification code of the file and the unique identification code of the folder retainer. Smith et al. fails to teach or suggest these features. Because the memory devices in Smith et al. are distributed and located at the location corresponding to the tape carrier, there would be no need to first access these memory devices to determine the location of a tape and the unique volume/serial number associated with the tape carrier.

Further, there would no need in the Smith et al. system to transmit a control signal that includes both the code of the file and the code of the folder retainer. Therefore, despite any teachings in the secondary references that may suggest the transmittance of a control signal including a unique identification code of a folder retainer, it would not have been obvious to modify the Smith et al. system to incorporate such a feature, since there appears to be reason why this would add any desirable function or feature to the Smith et al. system. Again, the fact that the Examiner contends that it would have been obvious to incorporate such features into the Smith et al. system suggests the Examiner has relied upon impermissible hindsight to reconstruct the present invention.

Regarding the use of hindsight, MPEP §2142 states:

> To reach a proper determination under 35 U.S.C. §103, the Examiner must step backward in time and into the shoes worn by the hypothetical 'person of ordinary skill in the art' when the invention was unknown and just before it was made. In view of all factual information, the Examiner must then make a determination whether the claimed invention 'as a whole' would have been obvious at the time to that person. Knowledge of applicant's disclosure must be put aside in reaching this determination, yet kept in mind in order to determine the 'differences' conduct the search and evaluate the 'subject matter as a whole' of the invention. The tendency to resort to 'hindsight' based upon applicant's disclosure is often difficult to avoid due to the very nature of the examination process. However, impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.

Applicants see no reasonable basis why one skilled in the art would have even considered the modifications proposed by the Examiner without having prior knowledge of Applicants' invention. Accordingly, Applicants submit that a *prima facie* case has not been established with respect to independent claim 28, or for that matter, with respect to any of the other claims pending in this application.

For the reasons stated above, Applicants submit that independent claim 28, as well as claim 29, which depends therefrom, are allowable over the teachings of Smith et al., Kott, Wakura, and Kubota whether considered separately or in combination.

CLAIMS 30-33

Independent claim 30 is directed to a file locating system comprising a combination of elements including at least a processor, a bus connected to the processor, a folder retainer connected to the processor by the bus, a plurality of file folders each including an addressable switch connected to the bus when the file folder is placed in the folder retainer and a conductor provided in the folder retainer and coupled to the bus for establishing a common communication path along which control signals issued from the processor are transferred to the addressable devices of at least two of the file folders. The use of a conductor that established a common communication path shared by all the file folders that are located in a folder retainer, is a feature that allows the files to be randomly placed in the folder retainer in a vertically stacked or horizontal abutting orientation, or hung in a file cabinet drawer in any random order.

Because the control signals transmitted to the tapes in the Smith et al. system are transmitted on dedicated lines separately connected to each tape, the Smith et al. system could not function properly if two tapes were placed in a single slot such that control signals would be provided to the two tapes over a common communication path. To the extent that Kott discloses the use of a common communication path for transmitting signals to the addressable devices on the docket card folders, Applicants do not believe that one skilled in the art would have considered modifying the Smith et al. system to include such a conductive rail since it would then be unable to receiver or otherwise separate the article identification code that must be sent from the device on each article to the processor to maintain the information stored in the local memory device. Thus, such a modification would appear to destroy the primary function of the Smith et al. system. The teachings of Wakura and Kubota do not suggest that any such modification would be possible or desirable. Accordingly, Applicants submit that independent claim 30 as well as claims 31-33, which depend therefrom are allowable over the teachings of Smith et al., Kott, Wakura, and Kubota whether considered separately or in combination.

CLAIMS 34 AND 42

Independent claim 34 is directed to an electronic file tracking system wherein each file folder includes a conductor located on the file folder that is configured so as to electrically couple the addressable device on each file folder to the electrical contacts of the folder retainer when the file folder is positioned in each of several different positions. None of the cited references teaches or suggests this feature. Specifically, in Smith et al., the tape cartridges do not include conductors that are configured to couple the memory device to the contacts in the tape carrier when the tape is positioned in any one of several different positions. Clearly, the slots and tape cartridges are dimensioned such that the tape cartridges may not be positioned in the tape carrier in more than one position such that electrical contact could still be made. The Kott reference does not disclose that the electrical contacts on the docket card folders would continue to make contact if the position of the docket card folder were in any different position than that disclosed in the patent. The Wakura and Kubota patents also fail to teach or suggest this feature. Accordingly, Applicants submit that independent claim 34 as well as claim 42, which depends therefrom, are allowable over the prior art of record.

CLAIM 35

Independent claim 35 is similar to claim 34. Claim 35 further recites that "for at least one file folder, said conductor is configured to electrically couple said addressable device to the electrical contacts of said folder retainer when said file folder is *positioned in each of several different orientations with respect to the electrical contacts*." While the folders of Kott may be placed in different locations along the length of the electrical conductor in the folder retainer, a change in orientation of any of the folders with respect to the electrical contacts would prevent electrical coupling to the addressable device on that folder. None of the references teaches or suggests this feature and therefore, Applicants submit that independent claim 35 is allowable over the teachings of Smith et al., Kott, Wakura, and Kubota.

CLAIMS 36 AND 37

Independent claim 36 is similar to claim 34. Claim 36 further recites that "for at least one file folder, said conductor is configured to electrically couple said addressable device to the electrical contacts of said folder retainer when said file folder is positioned *in each of several different positions with respect to an adjacent file folder.*" Applicants submit that neither Smith et al., Kott, Wakura, nor Kubota teaches or suggests a file folder having conductor configured to electrically couple an addressable device to electrical contacts of a folder retainer when a file folder is positioned in each of several different positions with respect to an adjacent file folder. Applicants therefore submit that independent claim 36, as well as claim 37, which depends therefrom is allowable over the prior art of record. It should be noted that claim 37 further recites that the conductors are configured to electrically couple the addressable device to electrical contacts of the folder retainer when the file folder is positioned in any one of several different *rotated* positions with respect to an adjacent file folder.

CLAIMS 38-41

As noted above with respect to the rejection of claims 38-41 over Smith et al., Gillotte, and Kott, the combination of Smith et al. and Kott fails to teach or suggest the system defined in claim 38. Applicants submit that neither Wakura nor Kubota teaches or suggests the deficiencies with respect to the Smith et al. and Kott references as applied to claim 38. Accordingly, Applicants submit that independent claim 38 as well as claims 39-41, are allowable over the prior art of record.

CLAIMS 43-45 AND 47-52

Independent claim 43 is directed to a file locating system comprising at least a database for maintaining general file information for a plurality of files including at least one of a description of contents within the file, file classification, a keyword list associated with the file, a title of the file, an originator of the file, an accessibility permission list for the file, location descriptions associated with the file location code, and historical information for a

plurality of files. None of the cited references teaches or suggests a file locating system that maintains such general file information in a database. Therefore, independent claim 43, as well as claims 44, 45, and 47-52, which depend therefrom, are allowable over the teachings of Smith et al., Kott, Wakura, and Kubota whether considered separately or in combination.

CLAIM 53

Independent claim 53 is directed to a file tracking system wherein the folder retainer is configured to support file folders that are stacked vertically upon one another such that each addressable device on each file folder in such a vertical stack, is coupled to the electrical contacts of the folder retainer through the conductive contacts provided on the file folders therebelow. None of the references cited by the Examiner teaches or suggests a folder retainer in a file tracking system that is configured to allow the vertical stacking of file folders upon one another while still allowing these files to be tracked by the system. Therefore, independent claim 53 is allowable over the cited references.

CLAIMS 54-58

Independent claim 54 is directed to a file tracking system comprising at least a plurality of folder retainers at least one of which is configured to support file folders an orientation different than that in which another folder retainer supports file folders, and a plurality of file folders, each including an addressable device and adapted to be communicatively coupled to the processor when the file folder is placed in any one of said folder retainers. None of the cited references teaches or suggests a file tracking system that allows for the use of different forms of folder retainers that support file folders in different orientations and also utilize file folders that are configured to be coupled to a processor when placed in any of these different folder retainers. Applicants submit that this is a distinct advantage insofar as most office environments utilize various forms of folder retainers. Therefore, independent claim 54, as well as claims 55-58, which depend therefrom are patentable over the teachings of Smith et al., Kott, Wakura, and Kubota whether considered separately or in combination.

CLAIM 46 IS REJECTED UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER SMITH ET AL. KOTT, WAKURA, AND KUBOTA FURTHER IN VIEW OF WARREN ET AL.

Claim 46 depends from independent claim 43, and therefore includes all the features of claim 43. Applicants submit that Warren et al. fails to teach or suggest the deficiencies with respect to Smith et al., Kott, Wakura, and Kubota as applied to claim 43. Therefore, claim 46 is allowable for at least those reasons stated above with respect to claim 43.

CLAIM 58 IS REJECTED UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER SMITH ET AL., KOTT, WAKURA, KUBOTA, AND "TOUCH THE FUTURE" PUBLICATION

Claim 58 depends from independent claim 54. Applicants submit that the "Touch The Future" publication fails to teach or suggest the deficiencies of the combined teachings of Smith et al., Kott, Wakura, and Kubota as applied to claim 54, and therefore, claim 58 is allowable for at least those reasons stated above with respect to claim 54.

In view of the foregoing remarks, Applicants submit that the present invention, as defined by the pending claims, is allowable over the prior art of record. The Examiner's reconsideration and timely allowance of the claims is therefore respectfully requested. A Notice of Allowance is earnestly solicited.

Respectfully submitted,

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